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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/813,852	03/07/1997	RODNEY L. DOCKERY	21651.3	3963

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EXAMINER

BARTUSKA, FRANCIS JOHN

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 04/25/2002

38

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

08/813852

Applicant(s)

R.L. DOCKERY et al

Examiner

F. J. BARTUSKY

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on MARCH 28, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 10, 17-23 AND 25-28 is/are pending in the application.
- 4a) Of the above, claim(s) 1, 4, 10, 17 AND 26-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-23 AND 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: ☐ approved ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Claims 1, 4, 10, 17 and 26-28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in Paper No. 27. The applicant cannot file an RCE to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined as a matter of right (i.e., applicant cannot switch inventions)(see 37 CFR 1.145 and MPEP 706.07(h)VII).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject

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matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 18, 22 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shedd in view of Bullard, Jr., both of record. Shedd discloses a book that is not restricted to just advertising, see page 1, col. 1, lines 2 and 3. The book of Shedd includes recipes which are articles of general interest and the recipes include a particular product of a

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distributor which comprises a specific brand, see page 2, col. 1, lines 21-33 and coupons which are linked to the particular products of the distributor, see page 2, col. 1, lines 33-45. Shedd does not disclose that the invention can be a magazine. Bullard, Jr. discloses in col. 2, lines 30-33 that in advertising media books and magazines are equivalent. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Bullard, Jr. to execute the invention of Shedd as a magazine as well as a book since Bullard, Jr. teaches in advertising media books and magazines are equivalent.

4. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shedd in view of Bullard, Jr. as applied to claim 18 above and further in view of Lamphere et al. Shedd, as modified by Bullard, Jr., shows a magazine with all the features of the applicants' claimed invention except for the magazine being specific to a particular store. Lamphere et al show a promotional booklet that is specific to a particular store, see col. 10, lines 51-61. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Lamphere et al to make the magazine of Shedd, as modified by Bullard, Jr., specific to a particular store to aid shoppers in finding the advertized products.

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5. Claims 20, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shedd in view of Bullard, Jr. as applied to claim 18 above and further in view of Lamphere et al. Shedd, as modified by Bullard, Jr., shows a magazine with all the features of the applicants' claimed invention except for disclosure of who commissioned the articles. It would have been obvious to one of ordinary skill in the art in view of the disclosure in col. 9, lines 5-12 of Lamphere et al to sell advertising space in the magazine of Shedd, as modified by Bullard, Jr., to store brands or national brands.

***Response to Amendment***

6. The Declaration under 37 CFR 1.132 filed March 28, 2002 and the Supplemental Declaration filed April 1, 2002 by Caleb J. Pirtle with supporting letters from Judy Cole, Jeff Stone, Ken Summers and Roger King are insufficient to overcome the rejection of claims 18-23 and 25 based upon 35 USC 103(a) as set forth in this Office action because: the Declaration does not establish a nexus between the claimed invention and the evidence of commercial success. The term "nexus" designates a factually and legally sufficient connection between the evidence of commercial success and the claimed invention so that the evidence is of probative value in the determination of nonobviousness. *Demaco Corp. v. F. Von Langsdorff Licencing Ltd.* 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988).

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The Declaration, Supplemental Declaration and letters do not establish a nexus between the claimed invention and the commercial success because it is clear from the Declaration, Supplemental Declaration and letters that Dockery House Publishing is providing more services than just those of the claimed invention. Specifically, in the letter of Ken Summers it is stated that the editorial staff worked to tailor original articles and photography to showcase the products and in paragraph 2 of the Declaration filed March 28, 2002, Mr. Pirtle states that he is involved in determining market trends and demands, that he works with customers to analyze their historic sales performance, their sales and marketing growth potential and their advertising or marketing budget needs. The commercial success must be derived from the claimed invention. In considering commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. *In re Mageli*, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973) (conclusory statements or opinions that increased sales were due to the merits of the invention are entitled

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little weight); *In re Noznick*, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973). The letters of Judy Cole, Roger King and Ken Summers provide opinions as to what motivates coupon redeemers but do not include any facts that the increased coupon redemption rate is due to the claimed invention.

Therefore, having considered the three factual inquiries specified in *Graham v. John Deere Co.*, 383 U.S. 1, 86 S. Ct. 684, 15 L. Ed. 2<sup>nd</sup> 545 (1966), 148 USPQ 459 and the factual allegations in the applicant's declaration in accordance with the provisions of 37 CFR 1.132, the rejections are deemed proper.

#### *Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. J. Bartuska whose telephone number is (703) 308-1111. The examiner can normally be reached on Monday through Thursday from 6:30 AM to 4:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9326.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

F. J. BARTUSKA  
PRIMARY EXAMINER